

**REMARKS**

Claims 1-23 are pending. Reconsideration of the present application is respectfully requested.

**I. The Claims Are Patentable over the Cited References**

The Office Action rejects claims 1–23 under 35 U.S.C. §103(a) over WO 0078286 to WU in view of U.S. Patent No. 6,296,156 to Lasserre et al. (“Lasserre”). The Office Action also provisionally rejects claims 1–16 under the judicially created doctrine of obviousness-type double patenting over claims 11–16 of copending Application No. 10/290,225 in view of Lasserre, and claims 11–38 of copending Application No. 10/244,519 in view of Lasserre. These rejections are respectfully traversed.

**A. Rejections Under 35 U.S.C. §103**

Applicants respectfully submit that the combination of Wu and Lasserre in the Office Action is based on inadmissible hindsight. The Office Action admits that Wu lacks a teaching of a rolled neck canister. And Lasserre does not teach or suggest a canister having a rim with a rounded edge adapted to prevent contact of a sharp edge with the rubber gasket. The problem related to the stability of the solution which is contained in the canister is in no way addressed by Lasserre. As discussed below, the aerosol dispensers disclosed by Lasserre and Wu have been designed to solve completely different problems.

Wu and the present application are directed to improve the stability of the product to be dispensed. But these two disclosures have different solutions. Wu provides inert can walls. The claimed invention provides: a “canister having a rim with rounded edges adapted to prevent contact of a sharp edge with said rubber gasket” as recited in claim 1. (Claims 17 and 21 include similar features.) In the pharmaceutical field, the stability of the formulations is of primary

importance for the efficacy of the formulation itself. Thus, special measures need to be taken into account when dispensing such formulation by means of a propellant dispenser.

In contrast, Lasserre aims to provide a versatile, easy to produce, leak tight dispenser as stated in col. 2, lines 39–57. To achieve this goal, Lasserre discusses a dispenser where the open end 8 of a container 4 is closed by a cup 5. The cup 5 bears first and second mounting means 6, 10 and an annular groove 12 which is radially deformable. A locking means is introduced into the groove to provide a leak tight closure.

The problem related to stability of the solution that is contained in the dispenser is not addressed by Lasserre. Contrary to the assertion in the Office Action, Lasserre does not try to keep away the solution from the metal part of the canister. In fact, Lasserre's containers which are mainly directed to the cosmetic filed (col. 1, lines 15–21) are preferably made of one-piece aluminum can or glass. These materials, if not specially treated or coated, would accelerate the degradation of medical formulation in the container.

Accordingly, in Lasserre, the closing cup is preferably made of plastic such as polyacetal, as described in col. 4, line 67. The assertion in the Office Action, referring to col. 1, lines 63–65, is misleading when it states that the internal surface of the cup which comes in contact with the product is coated with an inert thermoplastic layer. Actually, the coating of the cup with such a thermoplastic layer is considered a disadvantage as further explained in col. 1, line 66 through col. 2, line 2.

Moreover, Lasserre discloses that the neck of the container maybe rolled outwards or inwards with respect to the axis of the container only in connection with the problem that the profile of said neck has to engage with the mounting means. Lasserre in no way discloses or suggests to utilize containers with rolled necks to improve the chemical stability of an aerosol

formulation contained in the dispenser or even to prevent the corrosion of the dispenser valve by the product to be dispensed.

For all the above reasons, one skilled in the art would have had no reason to combine the teachings of Lasserre with Wu to try to improve the stability of a formulation contained in the dispenser. Furthermore, since Wu describes a coated valve, one would have been discouraged by the discussion in Lasserre that teaches away from such a combination (col. 1, line 66 through col. 2, line 2).

In any case, even if one would have combined the applied references one skilled in the art would not have arrived at the claimed invention. According to the teachings of Lasserre, the neck of the container maybe rolled outwards or inwards indistinctly. It should be appreciated that a rubber gasket according to the present invention could be damaged by being in contact with the neck rolled inward as shown in figure 4 and 5 of Lasserre. Therefore, the features recited in claim 1 of the present invention of “canister having a rim with rounded edges adapted to prevent contact of a sharp edge with said rubber gasket” would have not been taught or suggested by the applied references.

Applicants respectfully submit that there is no motivation taught or suggested by the applied references to modify the teachings of Wu with the teachings of Lasserre to obtain the claimed product. Applicants submit that only through hindsight would one be motivated to modify Wu to meet the features of the claims. MPEP §2141, under the heading “Basic Considerations Which Apply to Obviousness Rejections,” points out that “the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.” See *Hodosh v. Block Drug Co.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). The Federal Circuit has clearly held that “the motivation to combine references cannot

come from the invention itself.” *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 30 USPQ2d 1377 (Fed. Cir. 1993).

Accordingly, Applicants respectfully submit that the obviousness rejection of claims 1-23 should be withdrawn.

**B. Double Patenting Rejections**

A Terminal Disclaimer to Obviate a Provisional Double Patenting Rejection Over a Pending “Reference” Application is filed concurrently herewith. Thus, Applicants respectfully request withdrawal of the provisional rejections under the judicially created doctrine of obviousness-type double patenting.

**II. Conclusion**


In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-23 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants’ undersigned representative at the telephone number set forth below.

Any fees incident to this Amendment may be charged to Deposit Account No. 08-2665.

DATED this 9<sup>th</sup> day of May, 2006.

Respectfully submitted,

  
Jeffery M. Lillywhite, Reg. No. 53,220  
Holme Roberts & Owen LLP  
299 South Main Street, Suite 1800  
Salt Lake City, UT 84111  
(801) 521-5800